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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,958	01/29/2002	Michael Basara	3687-21	3563

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EXAMINER

MEREK, JOSEPH C

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,958

Applicant(s)

BASARA, MICHAEL

Examiner

Joseph C. Merek

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the article cannot be made by a different method and that the article and the method are so closely related so as to call into question that the claims are patentably distinct from each other. This is not found persuasive because the article can be made by a different method as described by the examiner and as shown in the reference to Dofsen et al (US 2,510,091). The reference teaches molding the inner part as seen in Figs. 5 and 9 where the inner layer is molded first and the outer layer is molded around the inner layer. Applicant's representative alludes that the method and the article may not be patentably distinct from each other. The restriction between article and the process of making the article has nothing to do with the two being patentably distinct from each other. This applies to species. See MPEP 806.05(f), which covers the distinctness of the product and the process of making the product. The examiner has shown and presented evidence that the article can be by a materially and different process.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,349,841. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are broader and encompass the subject matter of the patented claims. The claims of the instant invention allow for the additional layer in the patent claims. The process limitations required in claims 8 and 9 of the instant invention do not require any structure that is not in the patent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danielson et al (US 2,663, 910) in view of Gits (US 3,031,722). Regarding claim 7, as seen in Figs. 1-6, Danielson et al teaches a box-shaped hollow container at least a first discrete outer hollow body A and second discrete inner hollow body D interpenetrating with one and other to form an integral container structure, the integral container structure having a continuous inner surface without gap and an external surface patterned in a zone or section comprising a portion of the inner hollow body emerging through the opening in the outer hollow body to form a substantially continuous decorated outer surface with the opening located along the outer hollow body and having a shape and a size, said inner hollow body being formed along the inside of the first outer body and including a continuous inner surface and an outer surface having a raised portion corresponding in shape, size and thickness to the shape, size and thickness of the opening, the raised portion being formed within the opening and peripherally exactly and intimately matching the edge of the opening to form a smooth continuous outer surface along the container structure, said edge of the opening forming an acute angle at the junction of the edge with an outer surface of said first outer hollow body, said inner hollow body and the outer hollow body being formed of plastic material but does not teach openings and the openings being variously located along the outer surface and having various shapes and sizes. Gits '722, as seen in Fig. 2 and 3, teaches a similar structure to Danielson et al where the container has openings variously located along the outer hollow body and having various shapes and sizes. It would have been obvious to employ the openings of Gits '722 in the container of

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Danielson et al to provide an alternative design for the container or to include the letters that go with the numbers as taught by Gits '722. See Fig. 6 of Danielson et al where the inner surface of the inner hollow body is continuous and without gap since there are no gaps in the inner surface. The inner surface is smooth and continuous as seen in Fig. 6 from one side of the container to the other side. Danielson et al, as seen in Figs. 3 and 6, has tapered openings in the outer body and therefor the claimed angle is acute since it is less than 90 degrees when measured between the inner surface of the opening and the outer surface. Regarding claims 8 and 9, the outer hollow body and the inner hollow body are formed of a material that is capable of changing its physical state from a flowing fluid to a solid container. The materials of Danielson et al are injection molded and therefore must be fluid to flow into the mold. The materials harden into a solid when cooled. Moreover, the limitations do not require any structure in the article that is not in the combination of references.

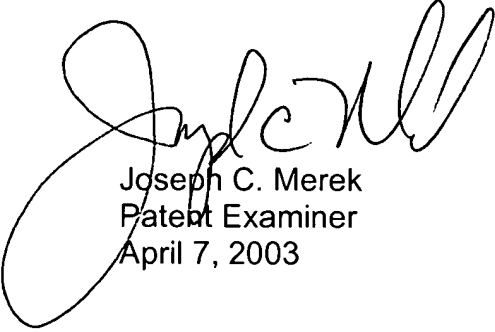
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dofsen et al, Shiho et al, Lenhart, and Downey are both cited for teaching molding the inner container first and then molding the outer container around the inner container. Matsui, Whitman, Gits '245, and Brunner are all cited for teaching the acute angle between the opening and the outer surface. Cooper is cited for teaching molding a container in two steps or shots.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Merek whose telephone number is (703) 305-0644. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 308-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Joseph C. Merek
Patent Examiner
April 7, 2003